IN THE UNITED STATES PATENT AND TRADEMARK OFFICE   DEC 2 0 2005

In re patent application of:

John K. Eckl	Attorney Docket No.: F-278
Serial No.:09/903,500	Group Art Unit: 3622
Filed: July 12, 2001	Examiner: Myhre, James W.
For: BILLING SYSTEM WITH ELECTRONIC AND PRINTED DISTRIBUTION	Date: December 20, 2005

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The appellant respectfully submits the following reply brief in response to the Examiner's Answer of October 31, 2005, in the appeal of the subject application. Appellant's corrected Brief was filed August 17, 2005, and the Notice of Appeal was filed on March 14, 2005, following a Final Office Action mailed December 14, 2004.

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being faxed to the United States Patent and Trademark Office, fax no. (571) 273-8300.

On December 20, 2005 Date of Transmission	Amy Harvey Name.
[signature] Signature	December 20, 2005 Date

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Argument

The arguments in the appellant's Brief and the Examiner's Answer focus on one central question: Does the Comensanas reference discose the claimed features whereby a recipient's delivery preferences are stored and used to determine the manner of delivery from a biller to the recipient?

The following facts about the disclosure of the Comesanas reference are not in dispute:

(1) The debtor can sign an agreement authorizing the creditor to include a return transmittal charge on the invoice.

(2) The invoice/payment transaction can occur by physical mail or electronic delivery.

The Examiner finds that the disputed claim terms (related to choosing a delivery method based on the recipient's stored "delivery preference") to be inherent based on the disclosure of items (1) and (2) in Comesanas. Accepting (1) and (2) as true, logic does not require that the "delivery preference" features be found inherent. However, in hindsight, and using Appellant's invention as a guide, it can be seen that it is quite reasonable to allow the debtor to express a preference as to the manner of delivery while signing the authorization agreement. However, as seductive and difficult to avoid as this aproach may be, such hindsight reasoning is not permissible and cannot beused to support rejection of the claims.

An objective review of the Comesanas reference reveals that collection or use of recipient delivery preferences are not disclosed or suggested anywhere in the reference nor are such receipient delivery preferences inherent. Rather, as described in the initial briefing, only the creditor is ever described in Comesanas as having the ability to choose the manner of delivery. With the manner of delivery predetermined by the creditor, the debtor then has the ability to choose whether to authorize the transmittal charges. Other scenarios suggested by the Examiner are based solely on an incorrect finding of inherency that is neither logically nor factually supported. See for example the figures, where flowchart decisions about transmittal charges are all linked back to the

agreement. In contrast, a decision about electronic transmittal (see bottom of first sheet of figures) has no linkage to the agreement.

In the prior Board decision, the Board selected a representative claim in which the disputed "delivery preference" features were arguably not affirmatively recited. In the current set of claims that problem has been corrected, and the issue is now properly presented. As such, a finding in favor of allowing the appealed claims will not be in conflict with the Board's July 14, 2004 decision, and will avoid further appeal process before a Federal Court.

For the reasons advanced above, the Appellant respectfully submits that claim 12 and 14-36 are patentable. All briefing now being concluded, reversals of the rejections by the Examiner are respectfully solicited.

Respectfully submitted,

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